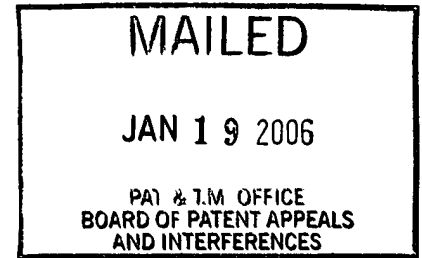


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRIET E. BRICHTA,
FLOYD PHILLIP LITTLEFIELD JR.,
BRUCE W. BRADBURY,
IVEOMA C. ERIKEN and
JULIO A. RODRIGUEZ



Appeal No. 2005-2309
Application No. 09/244,550

ON BRIEF

Before HAIRSTON, RUGGIERO, and NAPPI, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63, which are all of the claims pending in the present application. Claims 10-12, 15, 17, 36, 37, and 43 have been canceled. An amendment filed March 4, 2004 after final rejection has been approved for entry by the Examiner.

The claimed invention relates to a project management system and method in which milestones and milestone categories are mapped into project management tools. Various project tactic types are defined in terms of milestone categories required to complete a project of a particular tactic type with the defined tactic being mapped into the defined milestone categories. According to Appellants (specification, pages 14 and 15) the tactic and milestone mapping provides a translation across terminology and language boundaries which permits a project to be managed under a project management tool using different methodologies and terminologies.

Claim 1 is illustrative of the invention and reads as follows:

1. A program office management system, comprising computer software stored on a computer readable storage medium and operable to:

store informational data associated with accounts, projects, and programs;

store financial data associated with the accounts, projects, and programs;

store schedule and progress data associated with the accounts, projects, and programs;

store data associated with personnel, roles, and security access information thereof;

store a plurality of predefined tactics wherein each of the plurality of predefined tactics comprises an approach taken to affect change on a project;

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associate one or more predetermined project milestone categories with at least some of the plurality of predefined tactics;

store update data associated with the progress, actual expenditures, and labor resources of the projects and programs;

wherein the data associated with the security access information of personnel comprise a role definition of a coordinator having authorization to assign one or more persons to the at least one business unit, assign at least one role to each person, and add projects and accounts for the at least one business unit;

wherein the data associated with the security access information of personnel comprise a role table operable to store at least one valid role, and an authorization hierarchical organization of the at least one valid role, wherein the authorization hierarchical organization is associated with increasing levels of data access;

wherein the data associated with the security access information of personnel associates at least one of the valid roles relevant to the project to each person;

display data stored in the program office according to a predetermined security scheme based on the security access information stored in the program office database;

upon selection of a first tactic, comprising one of the plurality of predefined tactics, by a user for use on a particular project, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic; and

receive the update data on a periodic basis.

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The Examiner relies on the following prior art:

Knudson et al. (Knudson) 5,765,140 Jun. 09, 1998

Claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art

¹ The Appeal Brief was filed June 21, 2004. In response to the Examiner's Answer mailed August 11, 2004, a Reply Brief was filed October 12, 2004, which was acknowledged and entered by the Examiner as indicated in the communication mailed December 27, 2004.

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the obviousness of the invention as set forth in claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of

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obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 32, and 63 based on the Knudson reference, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art reference. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

As asserted by Appellants, (Brief, page 11; Reply Brief, page 3) we find no teaching or suggestion in the Knudson reference of the automatic association with a particular project a milestone having a particular milestone category that was previously associated with the approach tactic selected for the particular project, a feature present in each of the appealed independent claims 1, 32, and 63. Our interpretation of the disclosure of Knudson coincides with that of Appellants, i.e., at best, Knudson provides a disclosure of the revision of a project plan using a project planning tool using entered time to completion information for particular assigned tasks.

We recognize that the Examiner, at pages 7 and 8 of the Answer, has expanded upon the line of reasoning in support of the position asserting obviousness of the claimed invention over Knudson. The Examiner makes several assertions (id., at 7) as to what is "usual and widely known in the project management arts" with respect to the selection of tactics for project completion as well as the association of milestones with particular selected tactics, which assertions we find to be unsupported by any evidence of record.

As noted above, the Examiner has the burden of initially presenting a prima facie case of obviousness. The Examiner cannot satisfy this burden by simply dismissing differences between the claimed invention and the teachings of the prior art as being obvious. The Examiner must present us with an evidentiary record which supports the finding of obviousness. It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record before us.

It is well settled that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its

assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

We note that the Examiner, for the first time at pages 7 and 8 of the Answer, cites the additional references to Senn, Duncan, and Lowery in support of the Examiner's obviousness rejection of the appealed claims. To whatever extent these references may be applicable to the instant claimed invention, we will not consider them because they are not part of the statement of the rejection and may not be properly relied upon. "Where a reference is relied on to support a rejection whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." In re Hoch, 428 F.2d

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1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). See also Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claims 1, 32, and 63, as well as claims 2-9, 13, 14, 16, 18-31, 33-35, 38-42, and 44-62 dependent thereon, based on the Knudson reference is not sustained.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Accordingly, the decision of the Examiner rejecting claims 1-9, 13, 14, 16, 18-35, 38-42, and 44-63 is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


ROBERT NAPPI
Administrative Patent Judge

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